

REMARKS

The foregoing Amendment and remarks which follow are in response to the initial Office Action mailed August 7, 2002. In the Office Action, Claim 7 was rejected under 35 U.S.C. § 112, second paragraph. Furthermore, Claims 1-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hite et al. (U.S. Patent No. 6,002,393) in view of Hamilton et al. (U.S. Pub. No. 2002/0087973).

Rejection Under 35 U.S.C. § 112

Claim 7 has been amended to change "presentation data" to "alternative presentation data." Claim 7 depends (indirectly) from Claim 1. Claim 1 provides antecedent basis for "alternative presentation data." Thus, Applicants believe that the rejection of Claim 7 under 35 U.S.C. § 112 has been overcome.

Other Claim Amendments

Claim 26 has been amended to change "plying of the rich media segment" to "playing of the rich media segment" to correct a typographical error.

Rejections Under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d (BNA) 1438. Applicants respectfully submit that a *prima facie* case of obviousness has not been established based on the cited references. The amended claims are believed allowable. Reconsideration and withdrawal of the prior 103 rejections is respectfully requested.

In the Office Action, all of the claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hite et al. in view of Hamilton et al. A *prima facie* case of obviousness has not been established because there is not some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, *assuming arguendo*, that there was such a motivation, the prior art references (or references when combined) do not teach or suggest all of the claim limitations.

The Hite et al. reference discloses a system for targeting TV advertisements to individual consumers. Default commercials are

embedded within the programming. The targeted commercials are on other channels. The default commercial may be pre-empted and the targeted commercial shown instead of the default commercial. The targeted commercial may continue to be displayed even if the user changes the channel, i.e., if the user interrupts the display of the commercial, the commercial continues as though no interruption had occurred. In contrast, the Hamilton et al. reference discloses that certain events (including a channel change) may cause a delay in the display of data. Data, for example, advertisements or entertainment are stored locally, to fill in these delays. Thus, there is no suggestion or motivation to combine the references. *Assuming arguendo*, that there was such a motivation, the prior art references (or references when combined) do not teach or suggest all of the claim limitations as discussed below.

Independent Claim 1 recites that "the at least one rich media segment and the associated alternative presentation data be embedded within the plurality of programming segments." The Office Action argues that this limitation is taught by Hite et al. Applicants respectfully disagree. Hite et al. states that "[o]ne of these commercials, the default commercial, is embedded in the programming. The other commercials, the targeted commercials, are provided on other channels." Col. 11, lines 42-25. *Assuming arguendo* that the targeted commercials are "alternative

presentation data," they are not embedded in the programming segments.

Furthermore, the Hamilton et al. reference also does not teach this limitation. The Hamilton et al. reference states that "[w]hen a channel change (or other event associated with a display delay) occurs, the signal insertion module is notified, which then directs one or more **local signals** to the display device. [0036] emphasis added. The local signals are not embedded within the programming.

They are advertisements or other entertainment that have previously been stored so that they can be displayed to fill in during delay periods. Neither of the cited references alone or the combination of the references teaches or suggests that "associated alternative presentation data be embedded within the plurality of programming segments."

Claim 1 also recites "saving the alternative presentation data associated with the at least one rich media segment if presenting the at least one rich media segment on the selected channel is interrupted prior to completely presenting the at least one rich media segment on the selected channel." The Office Action correctly states that "Hite et al. does not teach to saving the alternative presentation data if presenting the at least one rich media segment on the selected channel is interrupted." The Office Action then goes on to argue that Hamilton et al. teach "a system

and a method for inserting local signals during a delay period associated with the execution of a channel change command, comprising immediately generating a signal to be displayed on TV upon detecting the channel change." The Office Action further states that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hite et al. to include the step of saving the alternative presentation data if presenting the at least one rich media segment on the selected channel is interrupted because it would make viewing TV aesthetically pleasant by allowing to quickly display the save image to eliminate unpleasant delay encountered during channel changing." Applicants respectfully disagree.

The Hamilton et al. reference discloses locally storing commercials or other entertainment to be used to fill in display delays. It does not teach that when presentation data embedded within programming segments is interrupted that alternative presentation data (which is also embedded within the programming segments) is stored at the time that the interruption in the presentation occurs. Neither of the cited references alone or the combination of the references teaches or suggests "saving the alternative presentation data associated with the at least one rich media segment if presenting the at least one rich media segment on the selected channel is interrupted prior to completely presenting

the at least one rich media segment on the selected channel."

As described above, neither of the cited and applied references, either alone or in combination, teaches all of the limitations of independent Claim 1. Therefore, Claim 1 is believed allowable over the prior art of record.

Because Claim 1 is believed allowable, all of the Claims depending from Claim 1, namely Claims 2-20 are also believed allowable. Additionally, many of the dependent Claims are allowable for additional reasons, some of which are described below.

Claim 3 includes the limitation that "presenting the alternative presentation data occurs simultaneously with the presenting of at least one of the programming media segments of the broadcast stream." For example, the alternative presentation data may be a banner advertisement that is displayed at the same time as the at least one of the programming media segments of the broadcast stream. *E.g.*, see, Page 5, lines 1-5. The Office Action argues that this limitation is taught by Hite et al. The cited text of the Hite et al. reference discusses substituting targeted commercials into live broadcasts, such as sporting events.

Claim 5 recites that "the alternative presentation data is presented for a time period equivalent to an initial length of time for a presentation of the at least one rich media segment less a

length of time that the at least one rich media segment has previously been presented." Neither Hite et al., Hamilton et al. or the combination thereof teaches or suggests that "the alternative presentation data is presented for a time period equivalent to an initial length of time for a presentation of the at least one rich media segment less a length of time that the at least one rich media segment has previously been presented."

Independent Claims 21 and 26 were rejected on the same bases as independent Claim 1 (described above). Independent Claim 21 recites a controller that is "configured to receive signals indicating the interruption of the rich media segment and to store the alternative presentation data associated with the rich media segment on the storage device when a signal is received from the viewer control interface indicating the interruption of the rich media segment" and independent Claim 26 recites a controller that is "configured to receive signals indicating the interruption of the rich media segment and to store the alternative rich media segment associated with the rich media segment on the storage device when a signal is received from the listener control interface indicating the interruption of the playing of the rich media segment." As described above with reference to Claim 1, neither of the references either alone or in combination teaches either of these limitations. Therefore, independent Claims 21 and

26 are also believed allowable over the prior art of record. Therefore, all of the claims depending from independent Claim 21 (Claims 22-25) and all of the claims depending from Claim 26 (Claims 27-30) are also believed allowable.

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached pages are captioned "Version with markings to show changes made."

In view of the foregoing, Applicants respectfully submit that Claims 1-30 are in a condition for allowance and such action is respectfully requested. In order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned at the Examiner's convenience.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

Claims 7 and 26 have been amended as follows:

7. (Once Amended) The method of Claim 6, further comprising transmitting the tracking information for the presenting of the alternative presentation data for storage in a database.

26. (Once Amended) A digital audio receiver for saving alternative presentation data associated with a rich media segment included in a broadcast stream when playing of the rich media segment on an audio output device is interrupted, the digital audio receiver comprising:

a listener control interface configured to allow the listener to interrupt the playing of the rich media segment;

a storage device for storing the alternative presentation data in response to the listener interrupting the playing of the rich media segment; and

a controller responsive to the listener control interface and connectable to the audio output device, the controller configured to receive signals indicating the interruption of the rich media segment and to store the alternative rich media segment associated with the rich media segment on the storage device when a signal is received from the listener control

interface indicating the interruption of the playing of the rich media segment.